

In re Appln.of Miller et al.
Application No. 10/765,514

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REMARKS

The Pending Claims

Currently pending are claims 1, 3-9, 12-27 and 30. Claims 2, 10, and 11 are canceled by this response. Claims 28-29 are withdrawn. Reconsideration of the pending claims is respectfully requested.

Summary of the Office Action

The Office Action dated June 2, 2006 sets forth a restriction requirement and requests affirmation of the provisional election of claims 1-27 and 30 earlier made on May 26, 2006. The Office Action also rejects claim 30 under 35 USC §102(b) as anticipated by Winstead (US 2604297). Claim 30 also stands rejected under 35 USC §102(b) as anticipated by Ogura et al. (US 6513659). Claims 1, 3-9, 16, 17, 19, 21, 22, 24-27 and 30 stand rejected under 35 USC §102(b) as being anticipated by Chemberlen (US 5584409). Claims 1, 6-8, and 16 stand rejected under 35 USC §102(e) as being anticipated by Clougherty et al. (US 6662827). Claims 17, 19 and 27 stand rejected under 35 USC §103(a) as being obvious over Clougherty et al. (US 6662827). Claims 1-27 and 30 stand rejected under 35 USC §103(a) as being obvious over Ogura in view of Domke (US 5326176).

Discussion of the Restriction Requirement

Applicants affirm, with traverse, the provisional election of claims 1-27 and 30 made during the telephone conversation with Applicants' representative Thomas Feix on May 26, 2006. The provisional election with traverse was made in response to the restriction requirement between Group I (claims 1-27 and 30) directed to a valve with a movable raised portion and a package and Group II (claims 28 and 29) directed to a method of removing fluid from a package that includes a valve element with a movable raised portion.

Concerning the traversal of the restriction requirement, Applicants submit that the Office fails to satisfy the requirements for a proper restriction requirement. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the examiner if

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restriction is not required. See, e.g., M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*” (emphasis added).

The Office has failed to allege or establish that examination of all of the claims would constitute a serious burden on the Examiner if restriction were not required. As such, Applicants respectfully requests the withdrawal of the restriction requirement and consideration of the claims of Group II, in addition to those of elected Group I.

Amendments to the Claims

Independent claims 1, 17 and 30 have been amended to point out and more particularly and claim more distinctly the subject matter of the invention. Specifically, claim 1 drawn to the valve element comprising two components including a base element and a membrane has been amended to recite the features previously set forth in (1) dependent claim 2 that the first position is a concave position and the second position is a convex position (2) dependent claim 10 that the base element comprises a flexible material and (3) dependent claims 11 that the membrane comprises a semi-rigid material. As such, claims 2, 10, and 11 have been cancelled without prejudice. Claim 17 drawn to a package including the two component valve element of claim 1 has been similarly amended to incorporate the substance of canceled claims 2, 10, and 11. Claim 30 directed to a package containing a single component valve element including a membrane has been amended to incorporate the substance of canceled claims 2 and 11. Claim 30 has been further amended to recite that the membrane is imperforate. Support for the imperforate membrane limitation in claim 30 is found in the specification as originally filed, see in particular the imperforate membrane 724 depicted in Figs. 25 to 28. No new matter is added by the current amendments to the claims.

Discussion of the Claim Rejections

Claim 30 was rejected under 35 USC §102(b) as anticipated by Winstead (US 2604297).

Winstead lacks the claimed imperforate membrane overlaying the opening in the bag sidewall. In direct contrast to the claimed invention as amended, Winstead discloses a valve element 8 provided with a circular series of small ports 11 (see Figs. 1-7, col.3, lines 4-5). When

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it is desired to deflate the package, Winstead discloses that the valve element be configured in a concave position as shown in Fig. 1. This allows air from inside the package to flow freely out through the ports 11 and aperture 5 (col. 3, lines 67-74). This again, is contrary to the invention as claimed which recites that the raised portion of the membrane obstructs the opening when configured in the second concave position.

Anticipation requires there be an identity of invention. Anticipation requires that all elements and limitation of the claim are found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosure. *Carella v. Starlight Archery and Proline Co.*, 804 F.2d 135, 138, 231 USPQ 644, 646 (Fed.Cir.1986). *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549, 220 USPQ 193, 198 (Fed.Cir.1983). *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781 (Fed.Cir.1983).

All the elements of claim 30 as amended are not found within Winstead. Accordingly, claim 30 as amended is patentable over Winstead.

Claim 30 was rejected under 35 USC §102(b) as anticipated by Ogura et al. (US 6513659).

Ogura lacks the claimed imperforate membrane overlaying the opening in the bag sidewall. In direct contrast to the claimed invention as amended, Ogura discloses a sheet for sealing 6 that include vent holes 7 offset from the opening 5 (see e.g., Figs. 1-2, col.7, lines 5-6). Ogura further lacks the claimed membrane comprising a semi-rigid material. Ogura instead discloses a valve element that comprises a gas non-permeable sheet of flexible material that is preferably an elastic material having an elastic recovering property (see col. 5, lines 8-15).

All the elements of claim 30 as amended are not found within Ogura. Accordingly, claim 30 as amended is patentable over Ogura.

Claims 1, 3-9, 16, 17, 19, 21, 22, 24-27 and 30 stand rejected under 35 USC §102(b) as being anticipated by Chamberlen (US 5584409).

Chamberlen lacks the claimed feature of amended claims 1, 17 and 30 wherein the first position of the configurable raised portion of the membrane is a concave position and the second position of the configurable raised portion is a convex position. Further, Chamberlen lacks the base element comprising a flexible material as recited in amended independent claims 1 and 17. Chamberlen lacks a membrane comprising a semi-rigid material as recited in amended claims 1,

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17, and 30. Further, Chamberlen lacks an imperforate membrane as recited in amended claim 30.

Chamberlen discloses an elastic membrane 34 and a rigid base member 10. As noted above, the membrane 34 is not configurable between a first concave position and a second convex position. The membrane 34 of Chamberlen remains in a generally convex position at both the open and closed states of the valve.

All the elements of independent claims 1, 17, and 30 as amended are not found within Chamberlen. Accordingly, independent claims 1, 17, and 30 as amended are each patentable over Chamberlen.

Claims 1, 6-8, and 16 stand rejected under 35 USC §102(e) as being anticipated by Clougherty et al. (US 6662827).

The Examiner states that Clougherty discloses “valve element 10 comprising a membrane including a border 32 and a raised portion 20 movable between a first obstructing position and a second non-obstructing position and a base element 38 including a border and aperture (unnumbered).”

Clougherty lacks the claimed feature of amended claim 1 wherein the first position of the configurable raised portion of the membrane is a concave position and the second position of the configurable raised portion is a convex position. The raised portion 20 of Clougherty’s membrane remains in a generally convex position at both the open and closed states of the valve.

All the elements of independent claim 1 as amended are not found within Clougherty. Accordingly, claim 1 as amended is patentable over Clougherty.

Claims 17, 19 and 27 stand rejected under 35 USC §103(a) as being obvious over Clougherty et al. (US 6662827).

The Primary Examiner correctly observes that “Clougherty is silent regarding the packaging structure.” Clougherty does not teach or suggest the claimed feature of amended claim 17 wherein the first position of the configurable raised portion of the membrane is a concave position and the second position of the configurable raised portion is a convex position. As noted above, the raised portion 20 of Clougherty’s membrane remains in a generally convex position at both the open and closed states of the valve. Further, the raised portion 20 of the membrane never obstructs the aperture on the package as recited in claim 17. Instead,

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Clougherty teaches to provide a permanently concaved center portion 24 (in a first embodiment of Figs. 1-3) or permanently concaved abutting portions 34 (in a second embodiment of Figs. 4-9) that are forced downward by a pre-stressed condition of the raised portion 20 when affixed to the base sheet 12 in order to close off the opening 18 in the base sheet 12 (col. 4, lines 20-27).

To render a claim obvious, the prior art reference as modified must teach or suggest all the elements of the claim. See, e.g., M.P.E.P. § 2143. There is no teaching, suggestion, or motivation in Clougherty to modify the permanently convex configuration of raised portion 20 or the permanently convex configuration of portions 24 or 34 to arrive at a membrane that is configurable between a first concave position and a second convex position as recited in independent claim 17.

Claims 1-27 and 30 stand rejected under 35 USC §103(a) as being obvious over Ogura in view of Domke (US 5326176).

The Primary Examiner states "Ogura teaches a valve element comprising a membrane having a domed central portion which has a first position to obstruct fluid communication through an aperture and a second position to allow fluid communication through the aperture." From these remarks it appears the Primary Examiner considers sheet 6 as a membrane. As noted above Ogura discloses sheet 6 as a gas non-permeable flexible material having an elastic recovery property. Further and as described in Example 1 beginning at col. 10, line 28, Ogura teaches that the sheet 6 is prepared from a silicone rubber sheet having a thickness of 1.5mm. Ogura does not teach or suggest a membrane that comprises a semi-rigid material as claimed in independent claims 1, 17, and 30.

With regard to Domke, the Primary Examiner states "Domke teaches a valve element for selectively facilitating fluid communication where the valve element either includes or does not include a base element attached to a border of the membrane, the base element including a seat portion and an aperture." From these remarks it appears the Primary Examiner relies on the embodiment of Fig. 7 which discloses a base plate 31 beneath membrane 10. Domke discloses that membrane 10 is a transparent flexible foil (col. 2, line 12-13) and that base plate 31 comprises polyvinyl chloride (PVC) or a similar material having a thickness of 150-250 μm .

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PVC is a tough and strong material of high tensile strength and PVC is not considered a flexible material, especially at a thickness of 150-250 µm.

The Primary Examiner states that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teaching of a base element to the valve of Ogura.” Applicants respectfully submit the independent claims 1, 17, and 30, as amended, are not obvious over Ogura and Domke. Moreover, the application of the rigid material base element of Domke to the Ogura valve that includes a flexible membrane would not arrive at applicants’ invention. Applicants’ invention as claimed in independent claims 1 and 17 is directed to a valve element that includes a base element comprising a flexible material and a membrane comprising a semi-rigid material. Applicant’s invention as claimed in independent claim 30 is directed to a valve element that includes a membrane comprising a semi-rigid material.

In view of the amendment to independent claims 1, 17, and 30 and the above remarks, it is believed that the prior art rejection of these claims is overcome and should be withdrawn. Claims dependent upon a claim that is not anticipated by a reference cannot be rejected under 35 U.S.C. § 102 and claims dependent upon a claim that is not obvious cannot be rejected under 35 U.S.C. § 103. See, e.g., *RCA Corp. v. Applied Digital Data Systems*, 221 U.S.P.Q.2d 385 (Fed. Cir. 1984); *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Since the cited references do not render independent claims 1, 17, and 30 anticipated or obvious, dependent claims 3-9, 12-16, and 18-27 are likewise patentable.

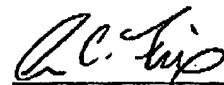
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Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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Respectfully submitted,



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